

The opinion in support of the decision being entered today was **not** written for publication in a law journal and is **not** binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KURT G. MELIA and RUSSELL D. ARTERBURN

Appeal No. 1997-1737
Application No. 08/330,168

ON BRIEF

Before STONER, Chief Administrative Patent Judge, FRANKFORT and
NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 9, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention involves a bushing apparatus and method for making fiber from a molten material such as molten glass (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Glaser et al. (Glaser) 1970	3,512,948	May 19,
Grubka et al. (Grubka) 1984	4,488,891	Dec. 18,
Fowler 1988	4,740,224	Apr. 26,

Claims 1 to 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fowler in view of Grubka and Glaser.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 14, mailed October 29, 1996) for the examiner's complete reasoning

in support of the rejection, and to the amended brief (Paper No. 13, filed October 11, 1996) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 9 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would

have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Rejections based on 35 U.S.C. § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

In the obviousness rejection before us in this appeal, the examiner combined three patents together to arrive at the admitted prior art.¹ The appellants have not contested the examiner's combination of the three patents. The examiner

¹ The appellants' Figure 1 is admitted prior art. In addition, the preamble part of the appellants' Jepson-styled claims 1 and 5 are admitted to be prior art. See 37 CFR § 1.75(e).

then ascertained that the combined teachings of the three patents did not arrive at the claimed invention since the claimed "height" of the bushing² as set forth in the claims under appeal (e.g., greater than about 0.2 inch and less than about 0.65 inch) was not taught. The examiner has not cited any evidence as to why it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have modified the applied prior art to arrive at the claimed invention. Instead, the examiner found that the appellants did not disclose any new or unexpected results due to the height difference between the rejected claims and the applied prior art and then determined (answer, p. 5) that it would have been obvious to make the bushing in a smaller or larger size.³ However, it is well established that the mere fact that a difference between the teachings of the prior art and the claimed subject matter does not provide any new or

² The "height" of the bushing is measured from the top surface of the orifice plate to the bottom surface of the flange.

³ We note that the examiner never determined that the claimed "height" would have been obvious at the time the invention was made to a person having ordinary skill in the art.

unexpected result does not, *ipso facto*, make that difference obvious under 35 U.S.C. § 103. Thus, the examiner's reliance (answer, p. 5) on Gardner v. TEC Sys., Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir.), cert. denied, 469 U.S. 830 (1984) to support a conclusion that the height difference would have been obvious is misplaced in this instance. In that regard, it is our view that Gardner did not establish a per se test that a change in a relative dimension is unpatentable absent any new or unexpected result.⁴ In any case, the appellants' specification (see, for example, pages 1-4, 7, 8 and 11) clearly sets forth that the claimed reduced "height" of the bushing permits the amount of the precious metal alloy needed to be reduced while maintaining, and usually improving, the consistency of the temperature and viscosity of the molten metal entering the nozzles of the bushing (i.e., a new and/or unexpected result).

For the reasons set forth above it is clear that the applied prior art is not suggestive of the claimed invention.

⁴ Gardner is a case turning on its specific facts. Thus, Gardner did not create a general obviousness rule.

Accordingly, the decision of the examiner to reject claims 1
to 9 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject
claims 1 to 9 under 35 U.S.C. § 103 is reversed.

REVERSED

BRUCE H. STONER, JR.)	
Chief Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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